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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,502	10/24/2003	Hiroki Koyano	CFA00016US	9274

34904 7590 01/24/2008
CANON U.S.A. INC. INTELLECTUAL PROPERTY DIVISION
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EXAMINER

ZHENG, JACKY X

ART UNIT	PAPER NUMBER
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2625

MAIL DATE	DELIVERY MODE
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01/24/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/692,502

Applicant(s)

KOYANO, HIROKI

Examiner

Jacky X. Zheng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19, 20, 22-25, 28-32 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-20, 22-25, 28-32 and 35-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on October 24, 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/28/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to applicant's amendments and remarks filed on November 7, 2007.
2. **Claims 19-20, 22-23, 25, 28-32 and 35-38** have been amended.
3. **Claims 1-18 (previously), 21, 26-27 and 33-34** have been cancelled.
4. **Claims 19-20, 22-25, 28-32 and 35-38** are currently pending.
5. The rejections under 35 U.S.C. §101, to Claims 32-38 are withdrawn in view of Applicant's amendments to the claims.
6. The rejections under 35 U.S.C. §112, Second Paragraph, to Claims 20-22 are withdrawn in view of Applicant's amendments, remarks and/or cancellation to the claims.

Information Disclosure Statement

7. The information disclosure statement (IDS) submitted on November 28, 2007 was filed after the mailing date of the application on October 24, 2003. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
11. **Claims 19, 25 and 32** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 19 are newly amended with limitations of "*a determining means for determining whether a form of printing object is the arbitrary form selected by selection means when a print processing using the composite form file is instructed*", "*generating a halt command to halt print processing using the arbitrary form when the determining means determine that the form of the printing object is the arbitrary form*", and (but not limited to) "*...generating the print job based on the form of the printing object and the page data when the determining means determines that the form of the printing object is not the arbitrary form*", and Applicant has not indicated any places in the disclosure for the supports of such limitations. Examiner has not found any *explicit* disclosure supporting at least the abovementioned limitations, such as "*determining means*", "*a form of printing object*", "*arbitrary form*" and etc. Claims 25 and 32 appears to have the identical issues. Therefore, claims 19, 25 and 32 are rejected for the abovementioned reasons, at least until the further clarification from Applicant indicating that such limitations are indeed being *explicitly* disclosed in the original disclosure at the time of the application filed.

Response to Arguments

8. Applicant's arguments filed November 7, 2007 have been fully considered but they are not persuasive.

9. In re Applicant's remarks from Page 11, 2nd paragraph to Page 12, 4th paragraph, regarding the rejection made under 35 U.S.C. §103(a), Applicant asserts that (a) "... present

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invention describes an overlay printing, as described in paragraph 0050 of the present specification, where data in a page unit is overlaid on a form such as “an estimate form” and “a bill form” ... so that user can set a sheet for an arbitrary form selected by the user to a printer before execution of the overlay printing by using the selected form” (in “Remarks”, Page 12, 2nd paragraph), and (b) “amended independent claim 19 ... allows a user to halt a printing process by using a selected form even if the number of pages to be generated changes due to page data such as an overlay printing” (in “Remarks”, Page 12, 3rd paragraph), and “halting a printing process at a position desired by a user when the number of pages to be generated changes due to page data such as overlay printing”. Applicant’s argument(s) are fully considered, however respectfully found to be not persuasive for at least the following reasons.

- a. With respect to argument (a), Examiner respectfully submits, the features upon which applicant relies (i.e., “an estimate form”, “a bill form”, “selected by the user to a printer before execution of the overlay printing”, etc.) are not recited in the rejected claim(s) (at least for the independent claims of 19, 25 and 32). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
- b. With respect to argument (b), Examiner respectfully submits *at least* the specifically-indicated limitations of “using a selected form even if the number of pages to be generated changes due to page data such as an overlaying printing” and “halting a printing process at a position desired by a user when the number of pages to be generated changes due to page data such as overlay printing” are not explicitly recited in instant claim 19, thus such descriptions will not be considered as required limitations by instant

claim in the process of consideration over the prior arts, at least until further amendment of the claims. Furthermore, examiner respectfully suggest if such specifically indicated limitations are intended to be claimed, such claim limitations or languages are required to be amended into the claim(s) for further or future consideration.

Therefore, for at least the reasons set forth above, the rejection made under 35 U.S.C. §103(a) over Anderson et al. and Johnson et al. with regard to the indicated claims is remained proper and therefore maintained.

10. In re Applicant's remarks from Page 12, 5th paragraph to Page 13, 2nd paragraph, regarding the rejection made under 35 U.S.C. §103(a) with regard to Claim 19, Applicant asserts that *"Claim 19 of the present invention also includes the feature of determining whether a form of a printing object is the selected arbitrary form when a print processing using a composite form file is instructed. Accordingly, a halt command can be generated at an appropriate timing. Neither Anderson or Johnson, either alone or in combination, are seen to describe or disclose at least the above-described feature of the present invention".* Applicant's argument(s) are fully considered, however found to be not persuasive for at least the following reasons.

- a. With respect to abovementioned argument, Examiner respectfully submits *at least* the specifically-indicated limitation of "a halt command can be generated at an appropriate timing" is not explicitly recited in instant claim 19, thus such descriptions will not be considered as required limitations by instant claim in the process of consideration over the prior arts, at least until further amendment of the claims. Furthermore, examiner respectfully suggest if such specifically indicated limitations are

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intended to be claimed, such claim limitations or languages are required to be amended into the claim(s) for further or future consideration.

Therefore, for at least the reasons set forth above, the arguments are found to be not persuasive and the rejection made under 35 U.S.C. §103(a) over Anderson et al. and Johnson et al. with regard to claim 19 is remained proper and therefore maintained.

10. In re Applicant's remarks on Page 13, 2nd paragraph to 4th paragraph, with regard to the remaining independent claims 25, 32 and the remaining corresponding dependent claims, Applicant asserts that the claims are allowable over the identical reasons indicated and as the dependent claims depend from the independent claims. However, since the rejection of claim 19 is maintained for reasons stated above, rejections of independent claims 25 and 32 (being drawn to the corresponding method and the computer-readable storage medium respectively) are also maintained for the substantially identical reasons, and the grounds of rejection for the corresponding dependent claims are also maintained since applicant has not pointed to any further deficiencies of the rejection.

(The grounds of rejection and/or objection are maintained for at least the responses set forth above, reasons of record set forth previously, and also replicated and provided in below.)

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 19 and 23-24** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Anderson et al. (U.S. Patent No. 6,483,999)** and further in view of **Johnson et al. (U.S. Pub. No. 2002/021454)**.

With regard to claim 19, the claim is drawn to an information processing apparatus that outputs document data, comprising means for displaying, selecting, setting, determining and generating a halt command. Anderson et al. disclose an invention relates to “a combination printer/copier” apparatus which is capable of triggering the interrupt sequence. Anderson et al. further disclose the limitations of: a display (see Anderson et al., i.e. Fig. 1, 22) as the displaying screen, a keypad (Fig. 1, 24) as means for selecting, a copy button (Fig. 1, 25) as the setting means for initiating the interrupting or halting command, a print controller (Fig. 2, 19) as the means for generating the interrupt sequence (or halting command) and generating of the print job, and image forming devices, such as inkjet or dot-matrix impact printer for example, as the outputting means. In addition, i.e. in Anderson et al. Figure 3, Step 33, disclose step of "comparing the current job parameters (or determining) to interrupt job parameter to determine if there is a conflict" and to further “evaluate the current job for a possible stopping point” (Anderson et al. i.e. column 4, lines 11-14).

With regard to claims 23 and 24, the claims are drawn to an information processing apparatus according to claim 19, further requiring the process of halting to be initiated by either a user or upon a expiration of a specific time period as claimed in claim 23; and capability of halting either the print job for specific page or the print job as a whole as claimed in claim 24. In addition to the teachings disclosed by Anderson et al. indicated above, the prior art further

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discloses “the interrupt sequence queries the user for the interrupt copy job parameter...the user accepts the default setting and initiates the interrupt copy job by depression of a single button...” (see Anderson et al., i.e. “Abstract”, lines 3-6); and further discloses that the control signal could also be rely upon the parameters, such as “approximate time left, etc.” (i.e. column 2, lines 60-64). In addition, Anderson et al. disclose displaying of the job status, such as number of page remaining and etc. for providing user feedback (i.e. column 2, lines 61-63), and also allow the print job to be cancelled or interrupted at a specific “point” (or at specific page) or “simply automatically cancel the interrupt job” (i.e. column 3, lines 13-17).

Anderson et al. do not *explicitly* disclose the limitation of “the halt command is inserted into the specific page selected form the document data”.

However, Johnson et al. disclose an invention relates to the printing control involves detection of “backchannel data”, and further utilize the information of presence or absence of a requesting command for “backchannel data” as the control signal for interrupting or halting control of printing processing (see Johnson et al., i.e. Paragraphs [0037]-[0038] and [0040] – [0042]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to have modified Anderson et al. to include the limitation of “the halt command is inserted into the specific page selected form the document data” taught by Johnson et al. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified Anderson et al. by the teachings of Johnson et al. to include the limitation of “the halt command is inserted into the specific page selected form the document data” taught by Johnson et al. to

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“make it possible for a printer to accommodate fast cancellation of print jobs, even when some print jobs request backchannel data” (see Anderson et al., i.e. Paragraph [0042]).

With regard to claim 25, the claim is drawn to a print processing control method of outputting document data having the *substantially identical* limitations recited and discussed in claim 19 (*The claim is rejected under the same ground for at least the reasons set forth above. See the detailed discussion of the claim 19 above. Furthermore, in Anderson et al., the method is also being claims, i.e. in claims 13-14 of Anderson et al).*

With regard to claims 30 and 31, the claims are drawn to a print processing control method of outputting document data having the *substantially identical* limitations recited and discussed in claims 23 and 24 respectively (*The claims are rejected under the same ground for at least the reasons set forth above. See the detailed discussion of the claims 23 and 24 above).*

With regard to claim 32, the claim is drawn to a print processing control program of outputting document data having the *substantially identical* limitations recited and discussed in claims 1 or 25 (*The claim is rejected under the same ground for at least the reasons set forth above. See the detailed discussion of the claim 1 above).*

With regard to claims 37 and 38, the claims are drawn to a print processing control program of outputting document data having the *substantially identical* limitations recited and discussed in claims 23 (or 30), and 24 (or 31) respectively (*The claims are rejected under the same ground for at least the reasons set forth above. See the detailed discussion of the claims 23 and 24 above).*

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13. **Claims 20 and 22** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Anderson et al. (U.S. Patent No. 6,483,999)** and further in view of **Turpin et al. (U.S. Patent No. 5,745,712)**.

With regard to claims 20 and 22, the claims are drawn to an information processing apparatus according to claim 19 and 20 respectively, further comprising “form generating means”, “a composite form file”, “a form configuration of the form (originally “document data”) in the composite form file (originally “a tree structure”) and etc. See the detailed discussions of the limitations required for the base claim of these dependent claims above.

Anderson et al. do not *explicitly* disclose the limitations of “form generating means”, “a composite form”, “a form configuration of the form included in the composite form file” and etc.

However, Turpin et al. disclose a system for creation and completion of “goal oriented electronic forms” that creates a graphical image data file which defines a graphical image of a form for display and printing (see Turpin et al., i.e. “Abstract”, lines 1-3; column 2, lines 34-41), and further disclose “a graphical image of tree branches, tree nodes and conclusions in association with fields of the form” (see i.e. “Abstract”, Figures 24-26).

Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to have modified Anderson et al. to include the limitations of “form generating means”, “a composite form”, “a form configuration of the form in the composite form file” taught by Turpin et al. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified Anderson et al. by the teachings of Turpin et al. to include the limitations of “form generating means”, “a composite form”, “a form configuration of the form in the composite form file” taught by Turpin et al. over the advantages, such as “define logical

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and/or mathematical operations which implement goal oriented prompting within a form...” (See Turpin et al., i.e. column 2, lines 36-41).

With regard to claim 29, the claim is drawn to a print processing control method of outputting document data having the *substantially identical* limitations recited and discussed in claim 22 above (*The claim is rejected under the same ground for at least the reasons set forth above. See the detailed discussion of the claim 22 above*).

With regard to claim 36, the claim is drawn to a print processing control method of outputting document data having the *substantially identical* limitations recited and discussed in claims 22 or 29 above (*The claims are rejected under the same ground for at least the reasons set forth above. See the detailed discussion of the claims 22 or 29 above*).

With regard to claims 28 and 35, the claims are drawn to a print processing control method and program according to claims 25 and 32 respectively, and further require “a form design application” and etc. (*See Turpin et al., i.e. claims 24-27 for further disclose of application software for creating “forms”*).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Lester et al. (U.S. Pub. No. 2003/0053110) disclose an invention relates to a printer is responsive to user input to cancel print jobs that are received after the user input.

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- B. Maekawa (U.S. Pub. No. 2003/0030836, Canon) disclose an invention relates to an image processing apparatus having an interrupting function for interrupting a print job which is being processed by an interruption job inputted from an external apparatus or a processing method of interrupting the print job which is being processed by the inputted interrupted job.
- C. Blom et al. (U.S. Pub. No. 2004/0099166) disclose a method of managing a print system in which print jobs are disposed with a print queue or "acting-object", is provided within the print queue to behave as a separate job.
- D. Yano (JP 2000-132347 A, Ricoh, a machine translation is provided and attached herein) disclose a method of a print job of plural pages is divided into the print job for the respective pages, each being managed for the respective pages and efficient printing is realized.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

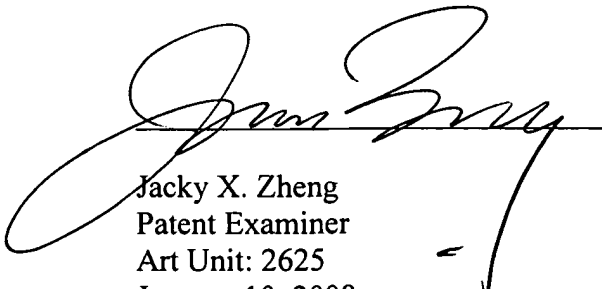
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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacky X. Zheng whose telephone number is (571) 270-1122. The examiner can *normally* be reached on Monday-Friday, 7:30 a.m.-5p.m., Alt. Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jacky X. Zheng
Patent Examiner
Art Unit: 2625
January 10, 2008



TWYLER LAMB
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